

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL L. WHITE and PATRICIA E. WHITE

Appeal No. 2001-0212
Application No. 08/958,497

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, FRANKFORT
and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 8 to 13, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a fluid filled amusement device. A substantially correct copy of the claims under appeal is set forth in the appendix to the appellants' brief.¹

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Bender 1979	4,162,855	July 31,
Murray, Jr. 1994 (Murray)	5,313,727	May 24,

Claims 8 to 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Murray in view of Bender.²

¹ Minor errors in claims 9 and 12 were noted by the examiner on page 3 of the answer.

² In the response to argument section of the answer (pp. 6-7), the examiner refers to U.S. Patent No. 4,852,283 to Teng. In rendering our decision in the rejection before us in this appeal we have not considered this patent since the examiner has stated that this patent does not form part of the rejection (see Paper No. 19, mailed June 27, 2000). See also In re Hoch, 428 F.2d 1341, 1342, 166 USPQ 406, 407 (CCPA (continued...))

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 17, mailed May 10, 2000) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 16, filed February 28, 2000) and reply brief (Paper No. 18, filed June 19, 2000) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references (i.e., Murray and Bender), and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's

²(...continued)
1970)(evidence that is relied upon must be positively set forth in the statement of the rejection).

rejection of claims 8 to 13 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In the rejection before us in this appeal, the examiner ascertained (answer, pp. 4-5) that Murray discloses the claimed invention except that Murray's impeller is driven by the drive shaft of a motor instead of "a magnetic drive rotor coupled to a magnetic impeller." The examiner then determined (answer, p. 5) that Bender teaches a magnetic drive rotor 20 coupled to a magnetic impeller 34 in a device which circulates

fluid in an enclosure and that it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the shaft/impeller assembly of Murray to have a magnetic rotor and magnetic impeller in view of Bender "in order to create a drive assembly which would not be prone to leakage between the upper housing and the lower housing."

The appellants argue (brief, pp. 13-19; reply brief, pp. 4-5) that there is no motivation or suggestion in the applied prior art to arrive at the claimed subject matter. We agree.

We have reviewed the teachings of Bender and Murray and fail to find any motivation or suggestion to have modified Murray in the manner set forth in the rejection before us in this appeal. Murray does not teach or suggest that his drive assembly is prone to leakage between the upper housing and the lower housing. Bender does not teach or suggest that his magnetic drive assembly was designed to prevent leakage. Thus, it is our view that the only suggestion for modifying Murray in the manner proposed by the examiner to arrive at the

claimed invention stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 8 to 13.

CONCLUSION

To summarize, the decision of the examiner to reject
claims 8 to 13 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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MICHAEL L. WHITE
P O BOX 10641
GLENDALE, AZ 85318-0641

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